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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/888,840	06/25/2001	Gary T. Wang	13780-2	9459

4743 7590 04/15/2003

MARSHALL, GERSTEIN & BORUN  
6300 SEARS TOWER  
233 SOUTH WACKER  
CHICAGO, IL 60606-6357

EXAMINER

HABTE, KAHSAY

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 04/15/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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# Office Action Summary

Application No.

09/888,840

Applicant(s)

WANG ET AL.

Examiner

Kahsay Habte, Ph. D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. Claims 1-27 are pending.

#### ***Election/Restriction***

2. Applicant's election with traverse of Group I, Claims 1-14 and 16-27 in Paper No. 12 is acknowledged. The traversal is on the ground(s) that the coexamination of the additional groups would not require an additional burden of search. The coexamination of each of the additional groups would require search of subclasses unnecessary for the examination of the elected claims. For example, the search for the invention of Group I would include search of subclass 544/296, 544/327, 544/122, 544/331, 544/332, the search for the invention of Group II would include search of subclass 546/255, 546/256 and 546/268.7 up to 546-269.7, the search for the invention of Group III would include the search of subclass 548/146, 548/206. Note that the search of thiazoles (Group III) would include both the 1,2-thiazoles and 1,3-thiazole. The same is true for oxazoles (Group IV) that consists of 1,2-oxazole and 1,3-oxazoes and are classified on subclass 548/215 and 548/240. Therefore, coexamination of each of these additional inventions would require a serious additional burden of search.

Applicants argue that there is no serious burden since the examiner own grouping (Group V) contains compounds having a variety of R1 and R3 groups, classifiable in classes such as 540, 544, 546, 548 and 564. The examiner disagrees with applicants. Group V is created to accommodate Groups that do not fall into major Groups I-IV. Note that if applicants had made Group V as their invention, they would

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have been required to elect a single disclosed species for examination. Note that a single compound cannot be classified into lower classes if the core structure is classified in higher classes. For example, if applicants elected a species with R1 or R3 = seven-membered ring with one nitrogen, class 540 is the only classification used to classify the group.

In regard to the argument that the core structure is the same for the groups, the examiner disagrees. The core structure of the invention is Formula II. Formula II contains different variables within the ring and outside the ring. Thus, the core structure is not the S attached to phenyl, but Formula II.

The requirement is still deemed proper and is therefore made FINAL.

### ***Objection***

3. The claims are drawn to multiple inventions for reasons set forth in the restriction requirement. The claims are examined only to the extent that they read on the elected invention. Cancellation of the non-elected subject matter is recommended in response to this Office Action.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-14 and 16-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention:

a. Claim 1 and claims dependent thereon are rejected because the dotted lines in formula II are not clear. What is the significance of the dotted line? It is recommended that applicants change the dotted line into a bond.

b. In claim 1 or elsewhere in the claims, the term "heterocyclyl" is indefinite.

✓ What is the size of the ring? What is the number and nature of the heteroatoms? Can the ring be fused or spiroconnected to another ring, and if so, what kind of ring? Can the ring be bridged? Unsaturated? Cf *In re Wiggins*, 179 USPQ 421, 423.

✓ c. In amended claims 1-9 and new claims (10-27), there is a vertical line on the right hand side of every page. Said lines are overlapping with the claims. It is recommended that applicants fix the problem.

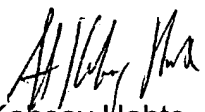
✓ d. In claim 14, there is no period. Applicants have to put a period after the chemical structure.

### **Conclusion**


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kahsay Habte, Ph. D. whose telephone number is (703) 308-4717. The examiner can normally be reached on M-F (9.00AM- 5:30PM).

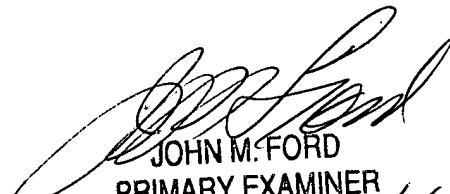
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

  
Kamsay Habte, Ph. D.  
Examiner  
Art Unit 1624

KH  
April 11, 2003

  
Mukund J. Shah  
Supervisory Patent Examiner  
Art Unit 1624

  
JOHN M. FORD  
PRIMARY EXAMINER  
GROUP - ART UNIT 1624